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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/306,448    05/06/99    WILLIAMSON

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EXAMINER
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QM12/0925

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PRELIMINARY	
ART UNIT	PAPER NUMBER

3738

DATE MAILED:

09/25/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/306,448**

Applicant(s)  
**Williamson IV et al**

Examiner  
**Paul Prebilic**

Group Art Unit  
**3738**



☒ Responsive to communication(s) filed on May 6, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 6, 2000 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3738

### *Specification*

The disclosure is objected to because of the following informalities:

On page 1 of the specification, the continuing data does not list the current status of the parent and grandparent applications.

In the specification, small case letters are used in Figure numeral designations with letters associated therewith, for example "50a", but large case letters are used in the drawings, for example "50A". This inconsistency could be confusing to one reading the application.

There are two sets of pages 74 and 75 in secession in the specification. For example, the specification has two copies of these pages and is therefore numbered as follows: 1-73, 74, 75, 74, 75, 76-89.

Appropriate correction is required.

### *Drawings*

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

The drawings are objected to because there is no Figure 50B on the 44 sheets of figures even though the specification sets one forth; see page 31 of the specification. Correction is required.

Art Unit: 3738

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-11 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 4-11, the claim scope is indefinite since the independent claims that claims 4-11 depend upon are directed to combinations, yet claims 4-11 are directed to the subcombination "tool". For this reason, it is unclear whether claims 4-11 are intended to be to a combination or subcombination which would give them a broader scope. For this reason, claims 4-11 will be interpreted as combinations of the tool and prosthesis.

With regard to claims 16-20, under subsection "A", subparagraph "(3)" thereof, the language of these subparagraphs renders the claim scope indefinite because they are drawn to the prosthesis after implantation and not any structure present on the device as claimed. Therefore, it is unclear what the language of these subparagraphs is intended to imply.

With regard to claim 19, lines 14-15 and claim 20, lines 14-15, it is unclear what "non-formed" means because the fastener has already been formed from metal and shaped.

Art Unit: 3738

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-19 and 47-104 of U.S. Patent No. 6,047,607.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims read on by what is set forth in the patented claims such that the present claims are clearly obvious in view thereof.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3738

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being obvious over US Patent No. 6,042,607 to Williamson et al which has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it constitutes prior art under 35 U.S.C. 102(e) since it is patented. The present claims are read on what is disclosed in the patented parent application. For this reason, the presently claimed invention is obvious over the patent alone because it has a different inventive entity, and thus, it constitutes prior art against the present claims.

This rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson, IV, et al (US 5,716,370) because the present claims are by another inventive entity, and thus, the patent constitutes prior art against the present claims and renders it obvious.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Copies of all the cited references are not being provided because all were provided in the parent application 08/802,948 and should be readily available therefrom.

Art Unit: 3738

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached on (703) 308-1065. The fax phone number for this Technology Center is (703) 305-3580.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
Art Unit 3738